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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/606,151	06/26/2003	Charles P. Gilliam	111325-450100	3546
22204 7590 08/25/2009 NIXON PEABODY, LLP 401 9TH STREET, NW SUITE 900 WASHINGTON, DC 20004-2128			EXAMINER SONG, HOSUK	
			ART UNIT 2435	PAPER NUMBER
			MAIL DATE 08/25/2009	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/606,151

Applicant(s)

GILLIAM ET AL.

Examiner

HOSUK SONG

Art Unit

2435

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 January 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-48, 147-173 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10, 20-34, 44-48, 147-158 and 168-173 is/are rejected.
- 7) ☒ Claim(s) 11-19, 35-43, 159-167 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 June 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 2/20/09, 10/15/08
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-10,20-34,44-48,147-158,168-173 are rejected under 35 U.S.C. 102(b) as being anticipated by Stefik(EP 0715247).

Claim 1: Stefik disclose specifying by a provider of an item, a computer-readable rights expression, wherein rights expression indicates a manner of use of item by a recipient of item and a condition for use of item, by recipient, condition indicating that user of item by recipient is subject to an authorization by a stakeholder in (page 9, Table 2; page 10, lines 25-52;page 12, lines 49-52). Stefik disclose associating rights expression with item in (page 11,lines 9-26). Stefik disclose receiving a request at a repository computing device for use of item from recipient and granting by stakeholder authorization for use of item by recipient in accordance with condition in (fig.1 and page 12,lines 49-52). Stefik disclose controlling repository computing device by stakeholder to thereby control use of item by recipient based on rights expression and authorization granted by stakeholder in (pages 8-9, Table 2,3; page 10,lines 25-47;page 12,lines 49-52).

Claim 2: Stefik disclose granting use of item by a first repository from a second repository and controlling second repository by stakeholder to control use of item by recipient in (fig.2 and page 3,lines 52-57).

Claim 3: Stefik disclose employing a digital ticket that references rights expression; specifying in rights expression that presentment of digital ticket is required for granting use of item by recipient and controlling digital ticket by stakeholder to control use of item by recipient in (page 25,lines 30-58).

Claims 4,6: Stefik disclose specifying by stakeholder in a rights expression a condition for use of item by recipient and associating rights expression of stakeholder with item in (page 11,lines 2-29).

Claim 5: Stefik disclose condition specified by stakeholder use of item by recipient is subject to authorization by a stakeholder in (page 12,lines 24-53).

Claim 7: Stefik disclose indicating at least one of respective conditions indicating that use of item by recipient is subject to respective conditions of a plurality of stakeholders in (page 12,lines 24-53).

Claims 8-10: Stefik disclose specifying by provider in rights expression in a condition indicating that use of item by recipient is subject to respective conditions of a plurality of stakeholders in (page 12,lines 24-56).

Claim 20: Stefik disclose rights expression includes a prohibited manner of use by recipient of item in (page 12,lines 53-56).

Claim 21: Stefik disclose usage right in (page 12,lines 53-56).

Claim 22: Stefik disclose access to item in (page 10,lines 25-32).

Claim 23:Stefik disclose recipient includes at least one of a user of item, a distributor of item and a consumer of item in (page 12,lines 49-52).

Claim 24: Stefik disclose item includes at least one of digital content, digital goods, digital services, non-digital content, non-digital goods and non-digital services in (page 3,lines 46-51).

Claim 25: Stefik disclose specifying by a provider of an item, a computer-readable rights expression, wherein rights expression indicates a manner of use of item by a recipient of item and a condition for use of item, by recipient, condition indicating that user of item by recipient is subject to an authorization by a stakeholder in (page 9, Table 2; page 10, lines 25-52;page 12, lines 49-52). Stefik disclose associating rights expression with item in (page 11,lines 9-26). Stefik disclose receiving a request at a repository computing device for use of item from recipient and granting by stakeholder authorization for use of item by recipient in accordance with condition in (fig.1 and page 12,lines 49-52). Stefik

disclose controlling repository computing device by stakeholder to thereby control use of item by recipient based on rights expression and authorization granted by stakeholder in (pages 8-9, Table 2,3; page 10,lines 25-47;page 12,lines 49-52).

Claim 26: Stefik disclose granting use of item by a first repository from a second repository and controlling second repository by stakeholder to control use of item by recipient in (fig.2 and page 3,lines 52-57).

Claim 27: Stefik disclose employing a digital ticket that references rights expression; specifying in rights expression that presentment of digital ticket is required for granting use of item by recipient and controlling digital ticket by stakeholder to control use of item by recipient in (page 25,lines 30-58).

Claims 28,30: Stefik disclose employing a digital ticket that references rights expression; specifying in rights expression that presentment of digital ticket is required for granting use of item by recipient and controlling digital ticket by stakeholder to control use of item by recipient in (page 25,lines 30-58).

Claim 29: Stefik disclose condition specified by a stakeholder use of item by recipient is subject to authorization by a stakeholder in (page 12,lines 24-53).

Claim 31: Stefik disclose indicating at least one of respective conditions indicating that use of item by recipient is subject to respective conditions of a plurality of stakeholders in (page 12,lines 24-53).

Claims 32-34: Stefik disclose specifying by provider in rights expression in a condition indicating that use of item by recipient is subject to respective conditions of a plurality of stakeholders in (page 12,lines 24-56).

Claim 44: Stefik disclose rights expression includes a prohibited manner of use by recipient of item in (page 12,lines 53-56).

Claim 45: Stefik disclose usage right in (page 12,lines 53-56).

Claim 46: Stefik disclose access to item in (page 10,lines 25-32).

Claim 47: Stefik disclose recipient includes at least one of a user of item, a distributor of item and a consumer of item in (page 12,lines 49-52).

Claim 48: Stefik disclose item includes at least one of digital content, digital goods, digital services, non-digital content, non-digital goods and non-digital services in (page 3,lines 46-51).

Claims 147-148: Stefik disclose stakeholder is a third party in (fig.1).

Claim 149: Stefik disclose specifying by a provider of an item, a computer-readable rights expression, wherein rights expression indicates a manner of use of item by a recipient of item and a condition for use of item, by recipient, condition indicating that user of item by recipient is subject to an authorization by a stakeholder in (page 9, Table 2; page 10, lines 25-52;page 12, lines 49-52). Stefik disclose associating rights expression with item in (page 11,lines 9-26). Stefik disclose receiving a request at a repository computing device for use of item from recipient and granting by stakeholder authorization for use of item by recipient in accordance with condition in (fig.1 and page 12,lines 49-52). Stefik disclose controlling repository computing device by stakeholder to thereby control use of item by recipient based on rights expression and authorization granted by stakeholder in (pages 8-9, Table 2,3; page 10,lines 25-47;page 12,lines 49-52).

Claim 150: Stefik disclose granting use of item by a first repository from a second repository and controlling second repository by stakeholder to control use of item by recipient in (fig.2 and page 3,lines 52-57).

Claim 151: Stefik disclose employing a digital ticket that references rights expression; specifying in rights expression that presentment of digital ticket is required for granting use of item by recipient and controlling digital ticket by stakeholder to control use of item by recipient in (page 25,lines 30-58).

Claims 152,154: Stefik disclose specifying by stakeholder in a rights expression a condition for use of item by recipient and associating rights expression of stakeholder with item in (page 11,lines 2-29).

Claim 153: Stefik disclose condition specified by stakeholder use of item by recipient is subject to authorization by a stakeholder in (page 12,lines 24-53).

Claim 155: Stefik disclose indicating at least one of respective conditions indicating that use of item by recipient is subject to respective conditions of a plurality of stakeholders in (page 12,lines 24-53).

Claims 156-158: Stefik disclose specifying by provider in rights expression in a condition indicating that use of item by recipient is subject to respective conditions of a plurality of stakeholders in (page 12,lines 24-56).

Claim 168: Stefik disclose rights expression includes a prohibited manner of use by recipient of item in (page 12,lines 53-56).

Claim 169: Stefik disclose usage right in (page 12,lines 53-56).

Claim 170: Stefik disclose access to item in (page 10,lines 25-32).

Claim 171:Stefik disclose recipient includes at least one of a user of item, a distributor of item and a consumer of item in (page 12,lines 49-52).

Claim 172: Stefik disclose item includes at least one of digital content, digital goods, digital services, non-digital content, non-digital goods and non-digital services in (page 3,lines 46-51).

Claims 173: Stefik disclose stakeholder is a third party in (fig.1).

Allowable Subject Matter

Claims 11-19,35-43,159-167 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Amendment

The Applicant's amendments filed on 1/8/09 have been considered. However, Applicant's submission of IDS on 2/20/09 necessitated the new grounds of rejection. See new grounds of rejection above.

Conclusion

Applicant's submission of an information disclosure statement under 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p) on 2/20/09 prompted the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 609.04(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

USPTO Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to HOSUK SONG whose telephone number is 5712723857. The examiner can normally be reached on mon-fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, KIM VU can be reached on 5712723859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2435

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/HOSUK SONG/

Primary Examiner, Art Unit 2435